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Washington, DC 20004-2623

EXAMINER

IZQUIERDO, DAVID A

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3738

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/720,176
Filing Date: November 25, 2003
Appellant(s): SHANK ET AL.

MAILED
OCT 17 2007
Group 370

Thomas S. Hahn
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 16 July 2007 appealing from the Office action
mailed 29 November 2006(1) **Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

A substantially correct copy of appealed claims 2, 3, 7, 23, 24, 28, and 29-35 appears on pages 18-20 of the Appendix to the appellant's brief. The minor errors are as follows: Claim 22, which reads "The composite stent of claim 28 further including a covering on one of said outer stent and said inner stent." has been omitted.

(8) Evidence Relied Upon

6,656,216

HOSSAINY et al.

12-2003

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

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Claims 2, 3, 7, 22-24 and 28-35 are rejected under 35 U.S.C. 102(e) as being anticipated by Hossainy et al. (U.S. Patent Number 6,656,216).

Hossainy et al. discloses a composite stent comprised of an outer stent (209) and an inner stent (100) wherein the outer stent is comprised of a bioabsorbable material (col. 4, lines 1-30) and exerts a radial force in an outward direction (col. 3, lines 44-56) and the inner stent is comprised of a metallic material (col. 2, lines 50-65) and also provides a radially outward force (col. 2, lines 60-col. 3, line 10).

(10) Response to Argument

Applicant has extensively argued that the composite stent as taught by the prior art, Hossainy et al. (“Hossainy”) fails to anticipate the claimed invention. Applicant’s arguments are primarily directed to the definition of a stent as all the claimed structure within the instant application has been anticipated by the Hossainy reference.

Firstly, with regard to claim language pertaining to the outer stent, Applicant has generally claimed an outer stent, wherein the outer stent is bioabsorbable stent being open at opposite ends having an outer surface engagable with the inner surface of a body lumen, an inner stent wherein the inner stent is “configured to provide a radially outward bias so as to position said outer stent into engagement with the body lumen (claim 7)” or “biased to position said bioabsorbable stent into engagement with the body lumen (claim 23)” or “configured to assist said outer stent in retaining a position of the outer stent within the body lumen (claim 28)” or “expanding said inner stent to cause said outer stent to be positioned into contact with an inner

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wall of the body lumen (claim 29)” wherein claims 30 and 33 claim substantially similar methods of expanding the inner stent into the outer stent.

Nowhere in the claim language is there any mention of the outer stent being capable of applying a radially outward force. Upon further examination of Applicant’s specification the only mention of these outer stents occurs in paragraphs 16 and 38 wherein the description states “the outer element may be, for example a *bioabsorbable stent typically constructed of a relatively non-resilient material such that the outer bioabsorbable stent may not be self-expanding* and subject to migration within the lumen over time. In contrast, the inner element may be, for example, and without limitation, a removable self-expanding metal stent (SEMS) *used to urge and maintain the position of the outer element in the body lumen.* (emphasis added. Para. 0016)” Again, there is no mention of the outer stent providing any radial outward force, in fact Applicant has described a complacent outer stent which is urged into position by the inner SEMS.

Furthermore, paragraph 0038, lines 12-14 of Applicant’s specification states that “[a]nother advantage of the present invention is that the outer element is not required to support the lumen wall by itself.”

Applicant has argued at length that the Hossainy reference cannot anticipate the claimed invention because it is not considered a stent and that the claims must be given their broadest reasonable construction in light of the specification as it would be interpreted by one of ordinary skill in the art.

However, Hossainy describes an outer band of regioselctive material (209) comprised of a bioabsorbable material (Col. 4, lines 1-30) wherein the band is open at opposite ends (See

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Figure 2) and is engagable with the inner surface of a body lumen (Col. 2 line 66 through Col. 3, line 19) as required by the claims in view of the specification. Therefore there would be no reason why the band as described by Hossainy cannot be characterized as a stent.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.


Respectfully submitted,

David A. Izquierdo



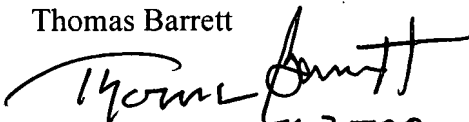
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